



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,603	04/16/2001	Satoru Todo	067242/0148	2083

7590

05/29/2002

Foley & Lardner  
3000 K Street N W Suite 500  
Washington, DC 20007-5109

EXAMINER

KWON, BRIAN YONG S

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 05/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/807,603

Applicant(s)

TODO, SATORU

Examiner

Brian S Kwon

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 April 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-53 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This Office Action supercedes the Office Action mailed November 15, 2001. The examiner withdraws the Election/Restriction Requirement mailed November 15, 2001.

#### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

**Group (A)**, claim(s) 15-34 and 50-53, drawn to a composition containing sPLA2 inhibitor represented by formula (I)-(XXIII).

**Group (B)**, claim(s) 35-49, drawn to a method of treating or preventing ischemia reperfusion injury with sPLA2 inhibitor represented by the formula (I).

The inventions listed as Groups A and B do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT rule 13.2, they lack the same or corresponding special technical features for the following reasons: The technical feature linking groups A and B appears to that they all relate to a sPLA2 inhibitor represented by formula (I)-(XXIII). However, the claimed compounds represented by formula (I)-(XXIII) are known in the art (EP 675110; US 5654326; US 5641800; EP 620214; (Draheim et al., J. Med. Chem. (1996), 39(26), 5159-5175); EP 675110; EP 620215; EP 675110; WO 96/031120; WO 9603376; WO 9603383; WO

Art Unit: 1614

9721664; WO 9721716; WO 9818464; WO 9824437; WO 9824756; WO 9824794; WO 9825609; US 5436258; US 5532366; US 5719149; US 5807829; US 5807829; US 5453443; EP 887342; WO 9847507; WO 9842343; WO 9837069). Therefore, the technical feature linking the inventions of groups A-B does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art. Accordingly, Groups A and B are not linked by the same or a corresponding special technical feature as to form a single general inventive concept.

2. If applicant elects Group (A) invention, it is subject to further restriction as following because they are not so linked as to form a single general inventive concept under PCT Rule 13.1 as reasoned above.

**Group A-I**, claim(s) 3-7, 33, drawn to a composition comprising formula (I)-(V).

**Group A-II**, claim(s) 8-11, drawn to a composition comprising formula (VI)-(IX).

**Group A-III**, claim(s) 12-13, drawn to a composition comprising formula (X)-(XI).

**Group A-IV**, claim(s) 14-15, drawn to a composition comprising formula (XII).

**Group A-V**, claim(s) 16, drawn to a composition comprising formula (XIII).

**Group A-VI**, claim(s) 17, drawn to a composition comprising formula (XIV).

**Group A-VII**, claim(s) 18, drawn to a composition comprising formula (XV).

**Group A-VIII**, claim(s) 19, drawn to a composition comprising formula (XVI).

**Group A-IX**, claim(s) 20, drawn to a composition comprising formula (XVII).

**Group A-X**, claim(s) 21, drawn to a composition comprising formula (XVIII).

**Group A-XI**, claim(s) 22-23, drawn to a composition comprising formula (XIX)-(XX).

Art Unit: 1614

**Group A-XII**, claim(s) 24-25, drawn to a composition comprising formula (XXI)-  
(XXII).

**Group XIII**, claim(s) 26-27, drawn to a composition comprising formula (XXIII).

3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1 as discussed above.

Applicant is required, in reply to this action, to elect a single disclosed species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added.

4. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. With the election of the specific species, a generic concept will be identified by the examiner as the inventive group for examination.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Kwon whose telephone number is (703)308-5377. The examiner can normally be reached Tuesday through Friday from 9:00 am to 7:00pm.

Art Unit: 1614

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel, can be reached on (703) 308-4725. The fax number for this Group is (703) 308-4556.

Any inquiry of a general nature of relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.



MARIANNE C. SEIDEL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

Brian Kwon

**ZOHREH FAY**  
**PRIMARY EXAMINER**  
**GROUP 1600**